

## REMARKS

Claims 1-22 are pending in the present Application. Applicant has amended claims 1, 2, 4, 11 and 12. Applicant has also canceled claim 22 and added claims 23 and 24. Consequently, claims 1-21 and 23-24 remain pending in the present Application.

In the above-identified Office Action, the Examiner indicated that claims 2, 12 and 22 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant has amended claims 2 and 12 to be in independent form and include the limitations of the base claims 1 and 11, respectively. Consequently, claims 2 and 12 are allowable as presented.

Applicant has amended claim 11 to include the limitation of claim 22, reciting that the automatic transmission includes a preset shift threshold and that if the GPS subsystem is off, the transmission subsystem sets the shift threshold to the preset shift threshold. Similarly, Applicant has amended claim 1 to recite that the step of adjusting the shift thresholds includes adjusting the shift threshold for the automatic transmission for the positioning data if it is determined that the performance of the automatic transmission can be improved and if the positioning data can be obtained using the GPS. Applicant has also amended claim 1 to recite that the step of adjusting the shift thresholds includes “setting the shift threshold to a preset shift threshold if the positioning data cannot be obtained using the GPS.” Accordingly, Applicant respectfully submits that claims 1 and 11 are allowable as amended.

In the above-identified Office Action, the Examiner rejected claim 4 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,038,505 (“Probst”). The Examiner also rejected claims 3 5-10, 13 and 15-21 under 35 U.S.C. § 103 as being unpatentable over Probst in view of U.S. Patent No. 6,098,005 (“Tsukamoto”).

Applicant respectfully traverses the Examiner's rejection. Claims 3 and 5-10 and claims 13-21 depend upon claims 1 and 11, respectively. Accordingly, Applicant respectfully submits that claims 3-10 and 13-21 are allowable as presented.

In the above-identified Office Action, the Examiner rejected claim 4 under 35 U.S.C. § 102 as being anticipated by Probst. In so doing, the Examiner stated that “[a]s per claim 4, it has been held that the recitation that an element is ‘can be’ [sic] perform a function is not a positive limitation but only requires the ability to so perform.”

Applicant respectfully traverses the Examiner's rejection. Applicant has amended claim 4 to be in independent form and to recite that the steps (c) and (c1) determine whether performance of the automatic transmission “is” improved if the automatic transmission performs an unnecessary shift a particular number of times. Claim 4 recites that an unnecessary shift is a shift that occurs for less than or equal to a particular amount of time. Claim 4 also recites that the shift threshold is adjusted if it is determined that the performance of the transmission is improved.

Neither Probst nor Tsukamoto, separately or in combination, teaches or suggests the method recited in claim. Probst is directed toward a system for controlling a transmission system based upon the surrounding environmental conditions. Probst, Abstract. Tsukamoto describes a system which also controls the transmission of a vehicle based upon the vehicles surroundings, such as upcoming intersections. Tsukamoto, Abstract. However, Applicant can find no mention in either Probst or Tsukamoto of determining that performance of an automatic transmission is improved if the transmission performs an unnecessary shift a particular number of times. Furthermore, Applicant can find no mention in Probst or Tsukamoto that the shift threshold is adjusted if it is determined that performance of an automatic transmission is improved if the transmission performs an unnecessary shift a particular number of times. Consequently, any combination of Probst and Tsukamoto would also fail to teach or suggest these features. Probst and Tsukamoto, separately or

in combination, fail to teach or suggest the method recited in claim 4. Accordingly, Applicant respectfully submits that claim 4 is allowable over the cited references.

New claims 23 and 24 recite a method and system that determine whether performance of the automatic transmission is improved utilizing the positioning data and the transmission data. Claims 23 and 24 recite that the performance of the automatic transmission is improved by a shift threshold adjustment if the automatic transmission performs an unnecessary shift. An unnecessary shift is a shift that occurs for less than or equal to a particular amount of time. Claims 23 and 24 also recite that the shift threshold for the automatic transmission for the positioning data is adjusted if it is determined in step that the performance of the automatic transmission is improved.

As discussed above with respect to claim 4, neither Probst nor Tsukamoto teach or suggest However, Applicant can find no mention in either Probst or Tsukamoto of determining that performance of an automatic transmission is improved if the transmission performs the recited unnecessary shift. Furthermore, Applicant can find no mention in Probst or Tsukamoto that the shift threshold is adjusted if it is determined that performance of an automatic transmission is improved if the transmission performs the unnecessary shift. Consequently, any combination of Probst and Tsukamoto would also fail to teach or suggest these features. Probst and Tsukamoto, separately or in combination, fail to teach or suggest the method and system recited in claims 23 and 24. Accordingly, Applicant respectfully submits that claims 23 and 24 are allowable over the cited references.

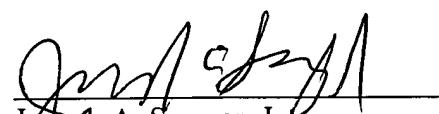
Accordingly, for the above-mentioned reasons, Applicant respectfully submits that the claims are allowable over the cited reference. Consequently, Applicant respectfully requests reconsideration and allowance of the claims as currently presented.

Attached hereto is a marked-up version of the changes made to the specification and

claims by the current amendment. The attached page is captioned "Version with markings to show changes made".

Applicant's attorney believes that this application is in condition for allowance. Should any unresolved issue remain, the Examiner is invited to call Applicant's attorney at the telephone number indicated below.

Respectfully submitted,



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

1. (Amended) A method for controlling an automatic transmission comprising the steps of:
  - (a) obtaining positioning data using a global positioning satellite (GPS);
  - (b) monitoring the automatic transmission to obtain transmission data;
  - (c) learning whether performance of the automatic transmission can be improved utilizing the positioning data and the transmission data; [and]
    - (d) adjusting a shift threshold for the automatic transmission for the positioning data if it is determined in step (c) that the performance of the automatic transmission can be improved and if the positioning data can be obtained using the GPS, and setting the shift threshold to a preset shift threshold if the positioning data cannot be obtained using the GPS.
  
2. (Amended) [The method of claim 1 further comprising the steps of:] A method for controlling an automatic transmission comprising the steps of:
  - (a) obtaining positioning data using a global positioning satellite (GPS);
  - (b) monitoring the automatic transmission to obtain transmission data;
  - (c) learning whether performance of the automatic transmission can be improved utilizing the positioning data and the transmission data;
  - (d) adjusting a shift threshold for the automatic transmission for the positioning data if it is determined in step (c) that the performance of the automatic transmission can be improved;
  - (e) determining whether a one-time event has occurred; and

(f) ensuring that the automatic transmission is at a factory setting if the one-time event has occurred.

4. (Amended) [The method of claim 1 wherein the learning step (c) further includes the step of:] A method for controlling an automatic transmission comprising the steps of:

(a) obtaining positioning data using a global positioning satellite (GPS);

(b) monitoring the automatic transmission to obtain transmission data;

(c) learning whether performance of the automatic transmission is improved utilizing the positioning data and the transmission data, the learning step (c) further including the step of

(c1) determining that the performance [can be]is improved if the automatic transmission performs an unnecessary shift a particular number of times, the unnecessary shift being a shift that occurs for less than or equal to a particular amount of time; and

(d) adjusting a shift threshold for the automatic transmission for the positioning data if it is determined in step (c) that the performance of the automatic transmission can be improved.

11. (Amended) A system for controlling an automatic transmission comprising:

a global positioning satellite (GPS) subsystem for obtaining positioning data using a GPS satellite;

a transmission subsystem coupled to the transmission and the GPS subsystem for monitoring the automatic transmission to obtain transmission data, for learning whether performance of the automatic transmission can be improved utilizing the positioning data and the transmission data and for adjusting a shift threshold for the automatic transmission for the

positioning data if it is determined that the performance of the automatic transmission can be improved; and

wherein the automatic transmission includes a preset shift threshold and wherein if the GPS subsystem is off, the transmission subsystem sets the shift threshold to the preset shift threshold.

12. [The system of claim 11] A system for controlling an automatic transmission comprising:

a global positioning satellite (GPS) subsystem for obtaining positioning data using a GPS satellite;

a transmission subsystem coupled to the transmission and the GPS subsystem for monitoring the automatic transmission to obtain transmission data, for learning whether performance of the automatic transmission can be improved utilizing the positioning data and the transmission data and for adjusting a shift threshold for the automatic transmission for the positioning data if it is determined that the performance of the automatic transmission can be improved; and

wherein the transmission subsystem further determines whether a one-time event has occurred and ensures that the automatic transmission is at a factory setting if the one-time event has occurred.

Please cancel claim 22.

23. A method for controlling an automatic transmission comprising the steps of:

- (a) obtaining positioning data using a global positioning satellite (GPS);
- (b) monitoring the automatic transmission to obtain transmission data;

(c) learning whether performance of the automatic transmission is improved utilizing the positioning data and the transmission data, the performance of the automatic transmission being improved by a shift threshold adjustment if the automatic transmission performs an unnecessary shift, the unnecessary shift being a shift that occurs for less than or equal to a particular amount of time; and

(d) adjusting a shift threshold for the automatic transmission for the positioning data if it is determined in step (c) that the performance of the automatic transmission is improved.

24. A system for controlling an automatic transmission comprising:

a global positioning satellite (GPS) subsystem for obtaining positioning data using a GPS satellite;

a transmission subsystem coupled to the transmission and the GPS subsystem for monitoring the automatic transmission to obtain transmission data, for learning whether performance of the automatic transmission is improved utilizing the positioning data and the transmission data, the performance of the automatic transmission being improved by a shift threshold adjustment if the automatic transmission performs an unnecessary shift, the unnecessary shift being a shift that occurs for less than or equal to a particular amount of time, the transmission subsystem also for adjusting a shift threshold for the automatic transmission for the positioning data if it is determined that the performance of the automatic transmission can be improved.